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No. 82-690

In the Supreme Court of the United States

OCTOBER TERM, 1982

GENERAL MOTORS CORPORATION,
Petitioner,

vs.

INTERNATIONAL TRADE COMMISSION
AND KUHLMAN CORPORATION,
Respondents.

PETITIONER'S REPLY BRIEF TO BRIEF FOR FEDERAL RESPONDENT IN OPPOSITION

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Dulude was told of the "format" via the Dooley disclosure, including the Kruse epoxy model. The staking technique Dulude substituted for epoxy is that of the prior art Schaad patent. Petition, p. 8. No synergistic effect is claimed. Appendix, 77a. See our unchallenged statement of the facts, Petition pp. 3-13.

The Commission considered the Dooley disclosure and the Kruse model as not "prior art". Appendix, 35a. Its analysis

purporting to follow *Graham* v *Deere* was on this basis. Appendix, 35a-41a. Nowhere did the Commission address the question of whether, with the Dooley disclosure and Kruse epoxy model in hand, it would have been obvious to substitute the staking technique of the prior art Schaad patent for the epoxy adhesive of the Kruse model. Moreover, the Commission ignored the finding of the Administrative Law Judge that it would have been obvious to try to stake and the absence any contention by Kuhlman that the idea of trying to stake the springs was the invention. Appendix, 77a, 73a.

The court below viewed the Commission opinion as considering the "substance" of the Dooley disclosures and noted the Commission finding that they were not as "pertinent" as the Schaad patent. Appendix, 14a. But it is meaningless to treat the Dooley disclosures as more or less "pertinent" than the Schaad patent, or merely to consider the "substance" of the Dooley disclosures. The proper inquiry — not made by either the court below or the Commission — is what the inventor claimed to have originally discovered and whether any claimed acts could qualify as an exercise of the inventive faculty.

The "meticulous" analysis relied upon by Federal Respondent at pages 4-5 misses the clear purport of this Court's rulings. Attention must be directed to what the inventor claims to have done and what acts could qualify as an exercise of the inventive faculty. It begs the question to recite the formula expressed in *Graham* v *John Deere Co.*, 383 U.S. 1, 17-18 (1966), without regard to the holding in the companion case of *Calmar* v *Cook Chemical*, 383 U.S. 1, 35, which requires consideration of the change in patent claim language that led to claim allowance. This Court's subsequent decisions in *Anderson's-Black Rock* v *Pavement Salvage Co.*, 396 U.S. 57 (1969); *Dann* v *Johnston*, 425 U.S. 219 (1976); and *Sakreida* v *Ag Pro*, 425 U.S. 273 (1976), similarly make clear that attention must be focussed

on what the inventor claims to have done and whether synergism is achieved. See also the dissenting opinion of Justice White, joined by Justice Brennan in *Roanwell Corp.* v *Plantronics*, 429 U.S. 1044 (1976), and the dissenting opinion of Mr. Justice Stevens, joined by Justices Brennan, Marshall, and Blackmun, in *Diamond* v *Diehr*, 450 U.S. 194, 205 (1981).

Contrary to Federal Respondent (brief, p. 8), a synergistic analysis is clearly required. The Commission squarely found that "All of the elements of the claims in issue, except the format of the needed assembly (including the requirement that the springs stand substantially parallel to one another while free and unconstrained), are found individually (but not in combination) in the prior art". Appendix, 41a. Considering such format to be not prior art, the Commission evidently considered this "element" technically not old and did not regard the admission of no synergism to be fatal. This was the main analysis of the court below. Each is wrong because Dulude derived the format of the assembly from Dooley, just as the Administrative Law Judge found and Respondent does not deny. Appendix, 76a-77a. Whether this "element" was derived knowledge not technically prior art, or was technical prior art, Dulude et al only combined elements they did not create — and the patent is invalid because no synergism is present.

The same result follows when the Dooley disclosure and the Kruse model are considered technical "prior art" under the alternative analysis of the court below. Hence the express rejection by the court below of the synergism standard (and therefore the statements of this Court in *Anderson's-Black Rock* v *Pavement Salvage Co.*, supra, and *Sakrieda* v *Ag Pro*, supra). Appendix, 15a. Only by such rejection could the court below uphold patent validity in the light of Respondent Kuhlman's refusal to assert that synergism is present. Appendix, 77a.

If the ruling below stands, an inventor can take what has been disclosed to him by others (the Dooley disclosure and Kruse epoxy model containing the desired format), substitute an element from the prior art to make the design better and cheaper (staking per Schaad in lieu of epoxy), and nonetheless obtain a valid patent. He need not even contend that the inventive faculty was exercised in relation to what he learned from the others, or advise the Patent Office of the derivation, or survive a court inquiry on whether something unobvious was done in relation to the totality of the prior art and the derived information. Instead, he need only rely upon the presumption of patentability and upon commercial success. A similar argument was rejected in *Hotchkiss* v *Greenwood*, 11 How. (52 U.S.) 248 (1850), and has remained rejected by unvarying decisions since that time. It should not now be countenanced.

The petition should be granted.

Respectfully submitted,

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